

Remarks

This Preliminary Amendment is in response to the Office Action mailed May 17, 2004. Claims 1, 4-11, and 13-17 were pending and the Office Action rejected all claims. Specifically, Claims 1, 4-7, 10, 11, and 13-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Fossum (2003/0103153) and Kozlowski (6,493,03). Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Fossum, Kozlowski, and Uno (5,296,696). Claims 9 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Fossum, Kozlowski, Uno, and Barna (6,445,022). Finally, Claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Fossum, Kozlowski, Barna and Uno.

In response, the applicant has cancelled Claims 11 and 13, amended Claims 1, 9, 14, and 16, and has added newly drafted Claims 19-21. The applicant also provides the following arguments in support of the allowance of the currently pending claims. In addition, the applicant has noted a drafting error in Figs. 3-6. Specifically, transistor M102 was initially shown as having a source connected to a ground, but in fact, M102 should be shown as being connected to a node between M105 and Vdrain. Corrected drawings have been submitted herewith, and no new matter has been added by this drawing correction.

As stated in *Ex parte Hiyamizu*, 10 USPQ 2d 1393, 1394-95 (BPAI 1988), “Under 35 U.S.C. § 103 where the examiner has relied on the teachings of several references, the test is whether or not the references viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art. It is to be noted, however, that citing references which merely indicate that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious.”

In the present case, the stated rejection merely point out that various parts or elements of the present invention may be found in other references. This is an insufficient basis to prove that the specific combination of elements as disclosed in the present application would have been obvious to one of skill in the art.

Moreover, the cited references include many elements in differing combinations which are NOT found in the present application. Only by referencing the present invention can the Examiner determine which elements to include and which to exclude. Such an exercise does not support an obviousness rejection and is improper. As stated in *Akzo N.V. v. United States International Trade Commission*, 1 USPQ 2d 1241, 1246 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987), "Prior art references. . . must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention. . . . Moreover, appellants cannot pick and choose among individual parts of assorted prior art references 'as a mosaic to recreate a facsimile of the claimed invention'".

In the present rejection, the Examiner has not considered how the specific references teach away from the present invention i.e. by teaching different circuits having different combination of elements. In fact, it is not clear that any of the hypothetical combinations proposed by the Examiner would even function.

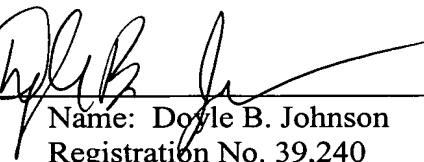
The Commissioner is hereby authorized to charge any fees (or credit any overpayment) associated with this communication and which may be required under 37 CFR §1.78 to Deposit Account No. 50-2603, referencing **Attorney Docket No. 354096.00701**.

A duplicate sheet is attached.

Respectfully submitted,

REED SMITH LLP

Dated: September 15, 2004

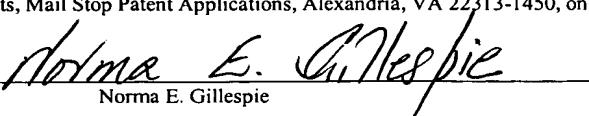
By: 
Name: Doyle B. Johnson
Registration No. 39,240
Attorneys for Applicants

Two Embarcadero Center, Suite 2000
P.O. Box 7936
San Francisco, CA 94120-7936
Direct Dial (415) 659-5911
(415) 543-8700 Telephone
(415) 391-8269 Facsimile

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express mail in an envelope addressed to: Commissioner for Patents, Mail Stop Patent Applications, Alexandria, VA 22313-1450, on September 15, 2004.

Dated: September 15, 2004


Norma E. Gillespie

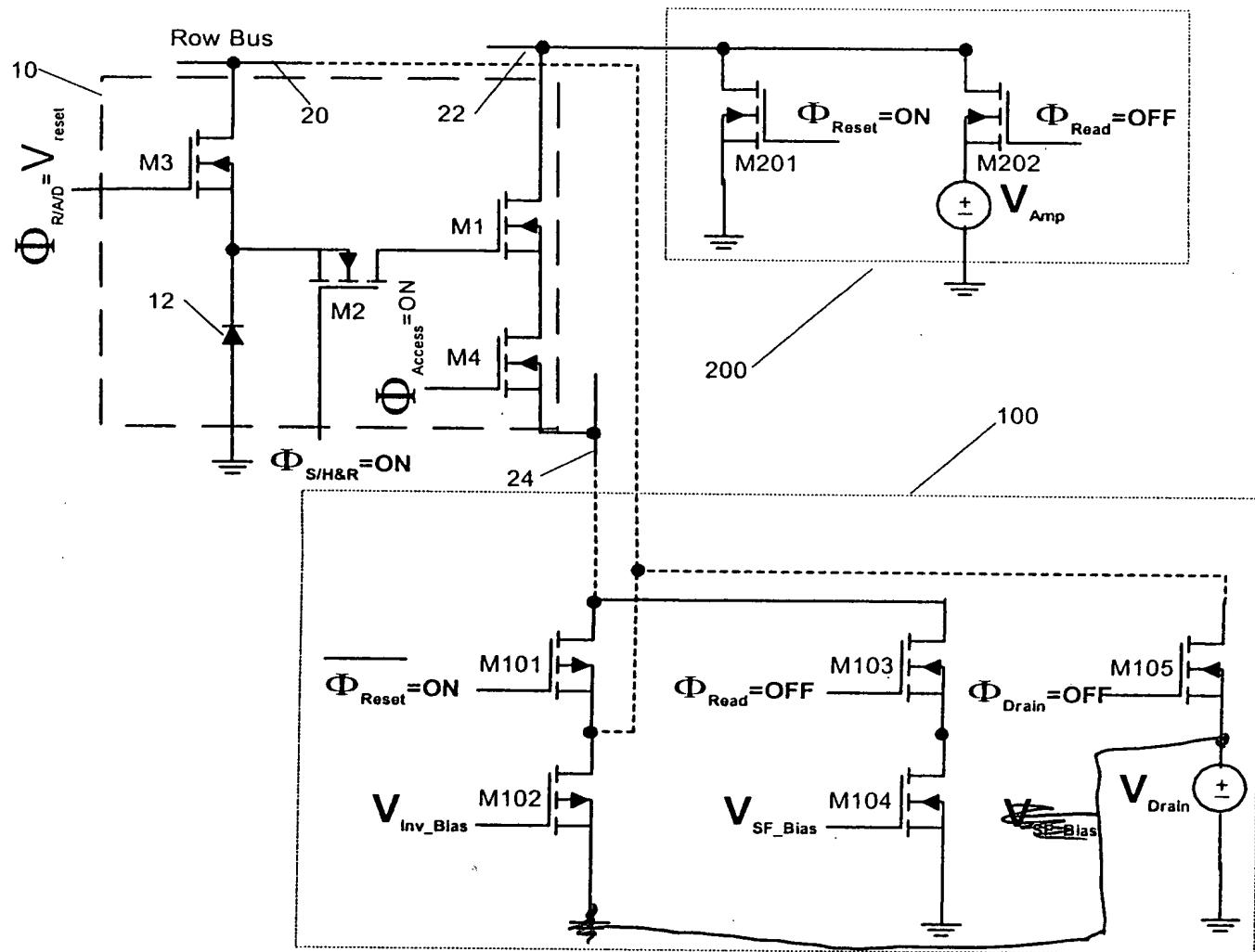


FIGURE 3 (RESET)

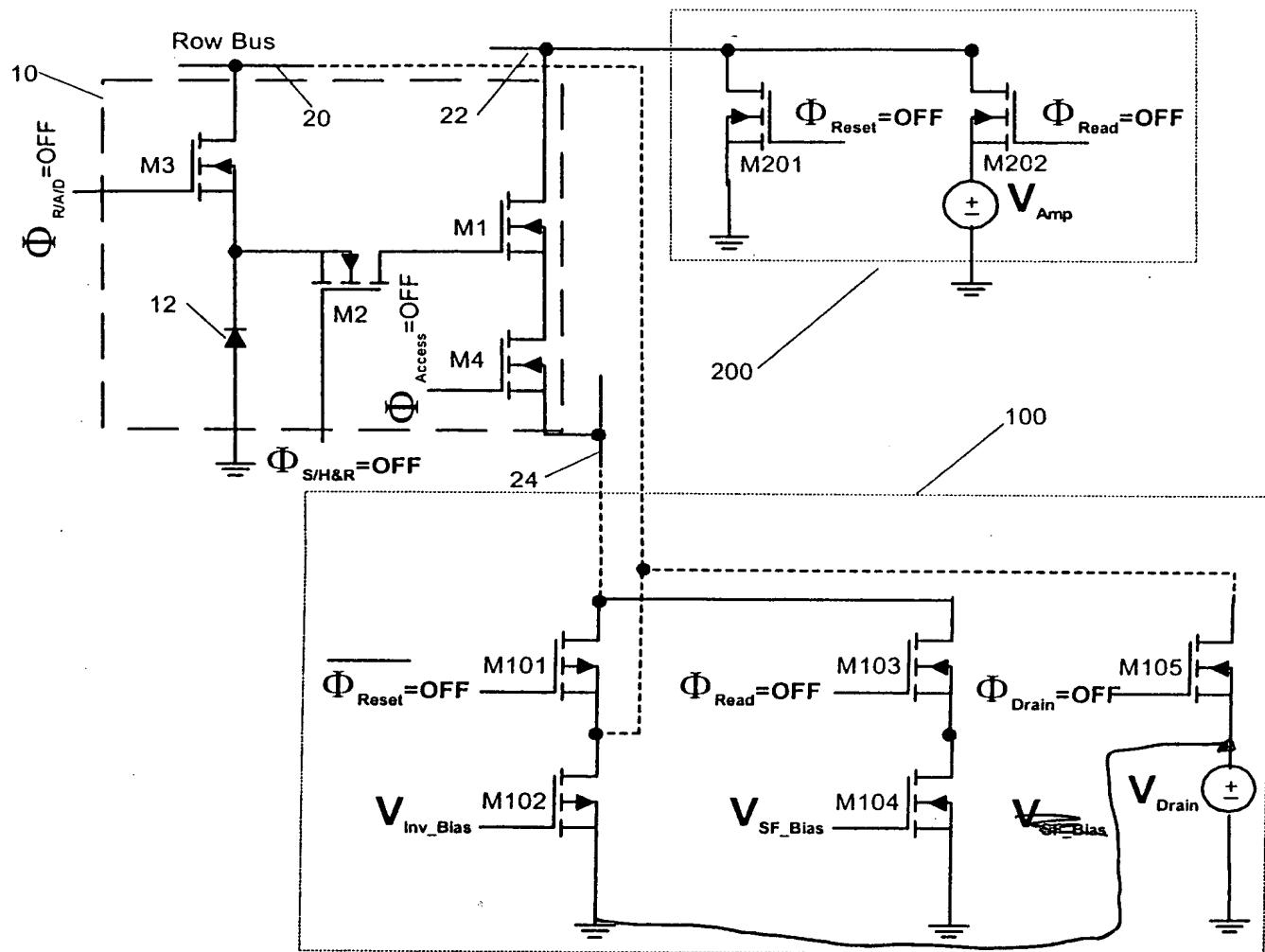


FIGURE 4 (INTEGRATE)

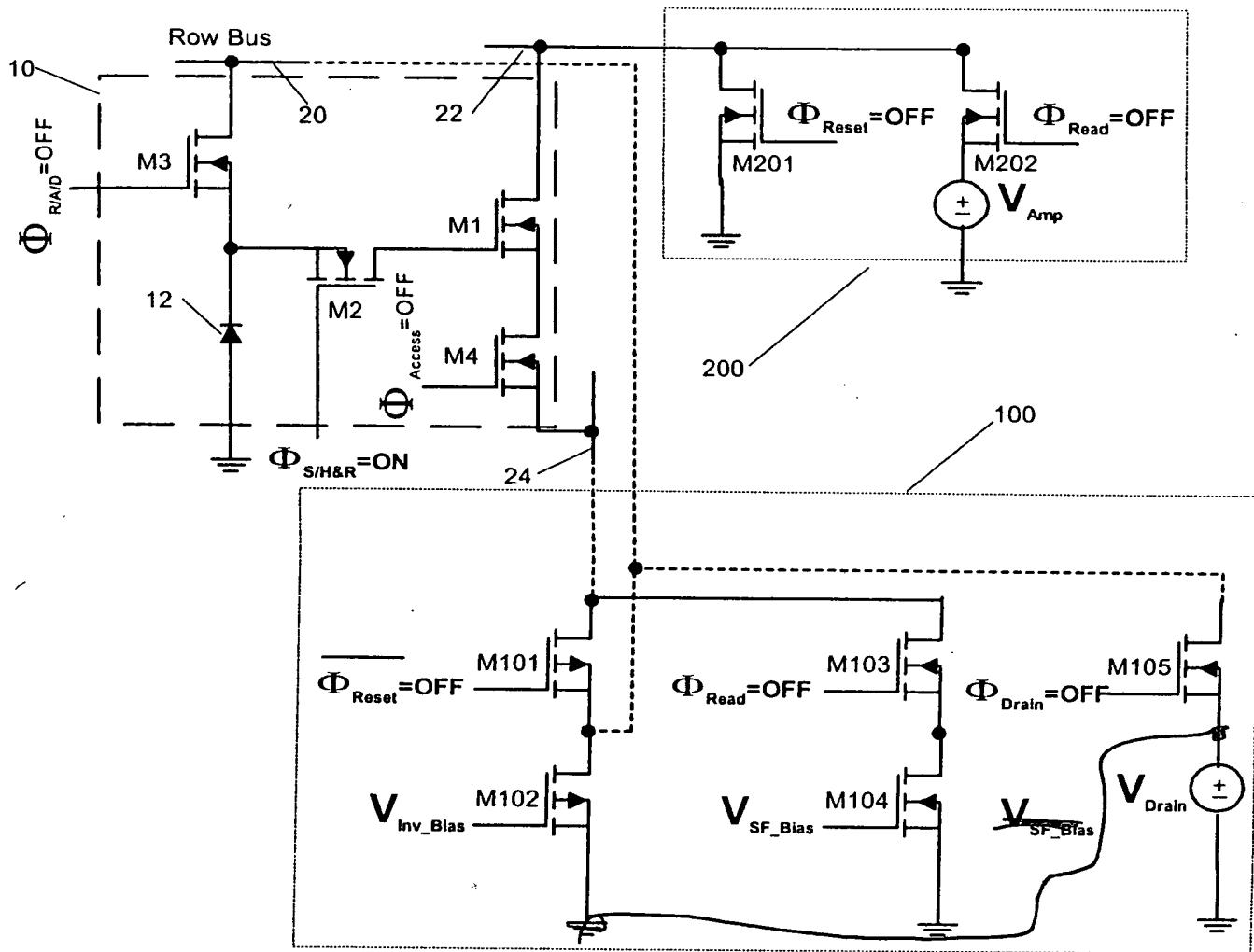


FIGURE 5 (SNAPSHOT)

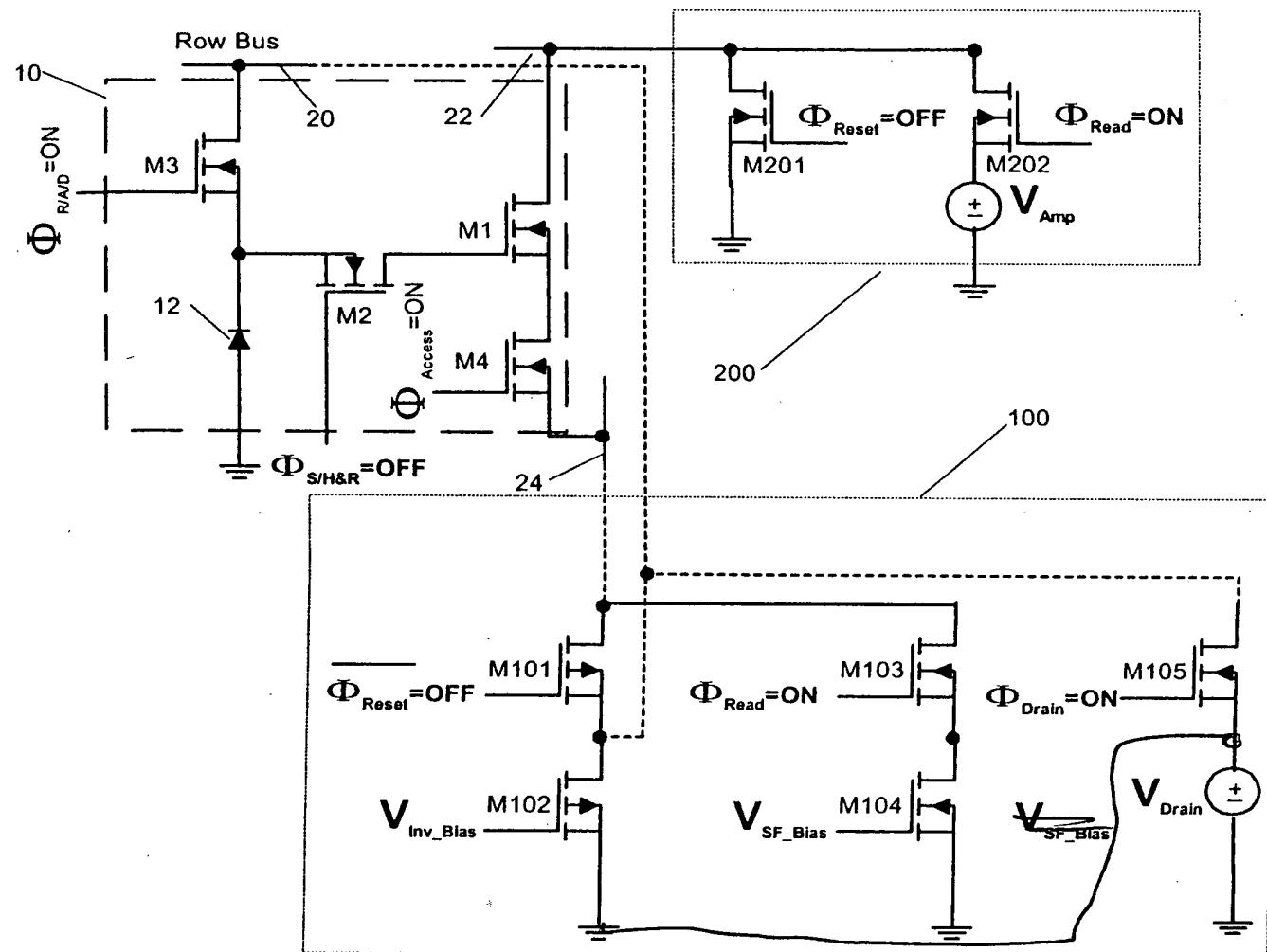
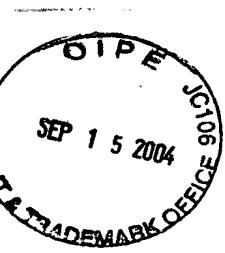
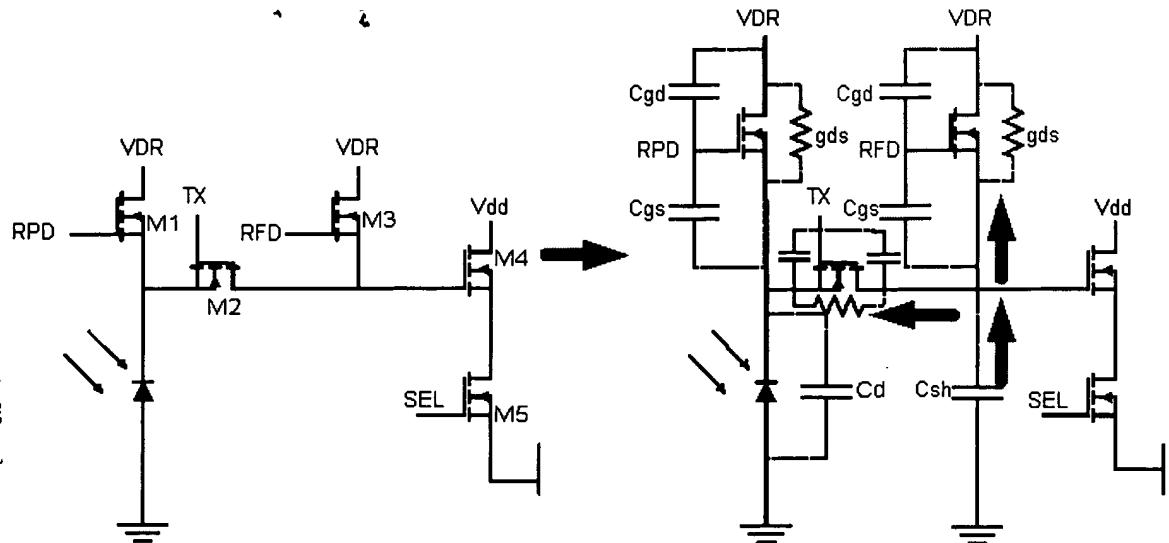
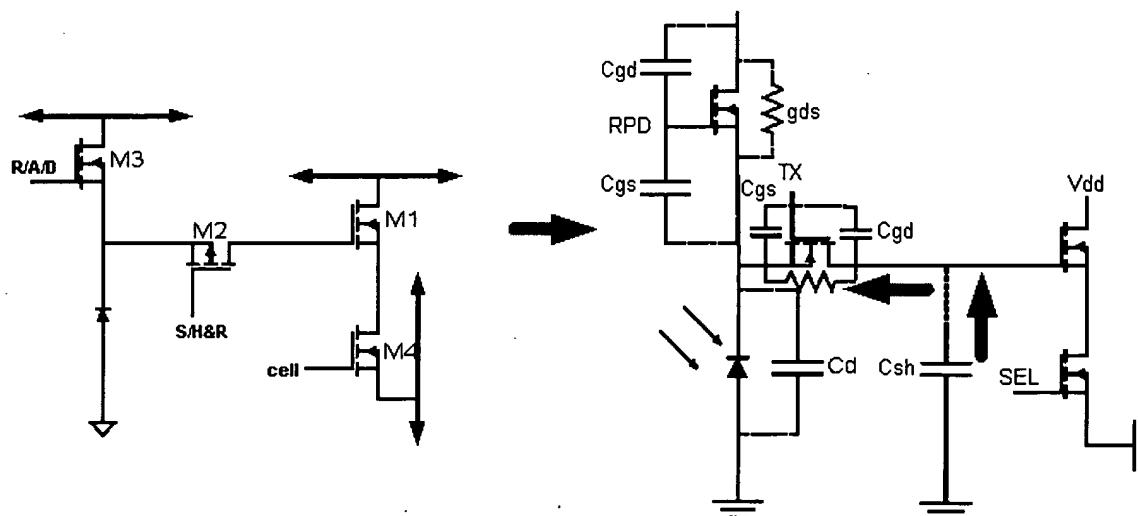


FIGURE 6 (READ)



US 2003/0103153
Fig. 2A

US 2003/0103153
(including parasitics of Reset and Transfer MOSFETs M1, M2 and M3)



99SC119
Fig. 2

99SC119
(including parasitics of Reset and Transfer MOSFETs M2 and M3)

Hypothetical combination of Fossum + Kozlowski